

## **REMARKS**

The patent owner respectfully traverses the rejections of record and requests that they be withdrawn, in view of this response.

### **Claim objections**

The Office is respectfully requested to reexamine and allow claim 15 in its rewritten form in the present merged reissue application and reexamination proceeding. The additional correction requested by the Examiner has been made.

### **No Recapture**

The applicant respectfully traverses the rejection of claims 18-64 on the basis of recapture. The claims do not recapture subject matter given up to avoid the prior art in original prosecution.

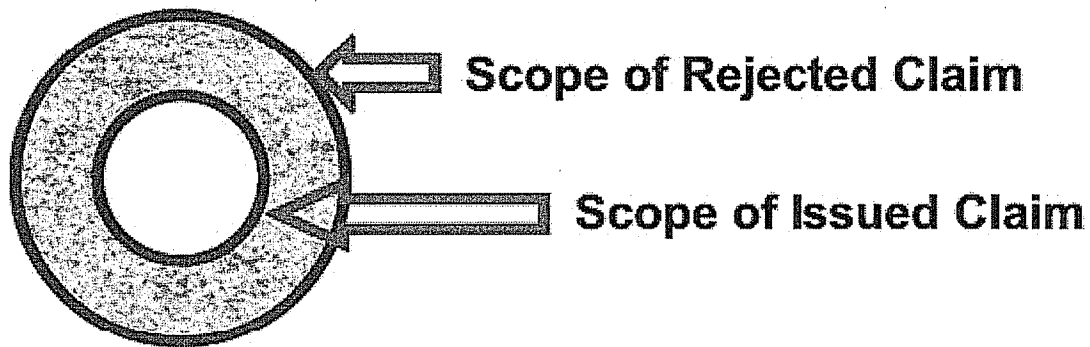
First, a tensile modulus of more than 300,000 psi, recited in Application claim 5 (patent claim 1) was not relied on to overcome the Hamlin reference in Ser. No. 08/280,210 Amendment filed December 1, 1995, pp. 3-5 – the prosecution history relied on in the Office action. Quoting from p.4 of the above-cited amendment, “a proximal shaft formed of PVC would not meet the requirements of claim 5. ... PVC [per the Hamlin prior art reference] may have a tensile modulus of more than 300,000 psi....” Claim 5 as then amended, and now as patent claim 1, recites, “a tensile modulus greater than 300,000 psi.” Thus, the response referenced in the Office action does not distinguish the Hamlin reference based on tensile modulus, but instead says the Hamlin reference “may have” the claimed feature.

Since the Office action relies solely on the 300,000 psi argument respecting Hamlin to find recapture respecting claims 18 and its dependent claims 19-52, and no argument was made during original prosecution that the 300,000 psi limitation distinguishes Hamlin, there is no recapture here and the rejection respecting these claims should be withdrawn.

Second, claims 53 and 57, while not reciting a tensile strength above 10,000 psi, and thus broader than Application claim 5 or patent claim 1 in that respect, are not

subject to rejection under the recapture rule because each claim also contains an additional limitation that is not recited in application claim 5 or patent claim 1, and that prevents operation of the recapture rule.

The applicant relies on *In re Eggert*, 2003 Pat. App. LEXIS 27; 67 U.S.P.Q.2d 1716 (Bd. Pat. App. & Interf. 2003) (designated citable as precedent). *Eggert* contains the following diagram that may be useful to understand its analysis.



**Drawing 1**

*Eggert*, 67 U.S.P.Q.2d at 1717. *Eggert* states, in relevant part,

For example, if an outer circle claim [**before the amendment to secure allowance**] contains elements **ABC** and the inner circle claim [after the amendment to secure allowance] contains elements ABCDEF, a reissue applicant cannot recapture a claim directed to elements ABC (outer circle) or a claim entirely outside the outer circle (e.g., AB, BC, ABC[BR] n2, etc.). However, **it is our view that the reissue recapture rule is not invoked for claims directed to elements ABCX, ABCD[BR], ABCEF,**

**A[BR]BCDEF**. In other words, the focus for determining the reach of the reissue recapture rule should be the claim from which the issued claimed directly evolved, not the issued claim itself.

n2 The subscript BR designates a broader element, thus element C[BR] is broader than element C.

*Eggert*, 67 U.S.P.Q.2d at 1718 (emphasis added).

In the present case, note in particular that for a claim previously given up designated as ABC (the claim given up during prosecution), the recapture rule as stated in *Eggert* did not form a basis for rejection of claim **A[BR]BCDEF**, even though A[BR] is broader than A, so the claim at issue is broader respecting element A than the claim ABC given up during prosecution. So long as the claim also is narrower than the claim given up in some other respect (as by adding one or more additional required elements DEF), then the claim ABC previously given up is not recaptured and the recapture rule is not violated.

Since this is a case of alleged argument-based recapture, the claim given up is hypothetical claim 1 without the 10,000 psi limitation. Allowance was previously gained by relying on the 10,000 psi limitation of the claim as originally filed – analogous to an amendment to hypothetical claim 1 to add the 10,000 psi limitation.

First consider Claim 57, which recites “a tensile modulus greater than 400,000 psi.” This is narrower than hypothetical claim 1 given up, which merely requires “greater than 300,000 psi.” Since the claim now presented is narrower in one respect than hypothetical claim 1 given up during prosecution, it can be broader in another respect, as by omitting the 10,000 psi limitation, and not violate the recapture rule.

Second, claim 53 also recites additional limitations (comparable to DEF above) that are not recited in claim 1 as presently presented, without the 10,000 psi limitation: an “intraluminal” catheter for “percutaneous insertion and transluminal advancement into a patient's vasculature.” These limitations are stated in claim 53, but not in hypothetical claim 1 given up. Again, a narrowing limitation in one respect, compared to

the hypothetical claim 1 given up during prosecution, compensates for a broadening limitation in another respect.

Third, dependent claims 54-56 (depending from 53) and 58-64 (depending from 57) add more additional limitations not to be found in hypothetical claim 1 given up during prosecution, which again make the recapture rule inapplicable.

Finally, claims 61 and 63 contain a "greater than 10,000 psi" limitation, so even if that limitation were necessary (and it is not, as shown above), those claims cannot be rejected under the recapture rule because they recite that element, unlike hypothetical claim 1 given up during prosecution.

For the stated reasons, the claims do not represent prohibited recapture.

#### **Claim Rejections**

- **35 U.S.C. § 102/103 – Claims 57-64 – Beisel, Muni**
- **35 U.S.C. § 103 – Claims 18-22, 26, 27, 31-48, 51-56 – Beisel, Goltzer, Muni**
- **35 U.S.C. § 102/103 – Claims 18, 24, 25–Muni, Beisel**
- **35 U.S.C. § 103 – Claims 28-30, 49, 50 – Beisel, Muni**
- **35 U.S.C. § 103 – Claims 1-17, 23 – Muni, Beisel, Cornelius**

The rejections identified in the headings above all depend in whole or in part in alleged prior art status of the Beisel PCT publication reference, which was published January 20, 1994. The Beisel reference is overcome as prior art by the enclosed Declaration Of Inventors Under 37 C.F.R. § 1.131, which shows conception of the present invention before January 20, 1994, constructive reduction to practice on July 25, 1994, and reasonable diligence in reducing the invention to practice from before January 20, 1994, to July 25, 1994.

The enclosed declaration is signed, on separate copies, by the two available inventors, Mr. Ainsworth and Mr. Wasicek. The third inventor, Mr. Tai Cheng, is unavailable, which is addressed in the declaration.

*In Reissue Application Serial No.: 09/143,503*  
*In Reexamination Control No.: 90/004,946*  
Amendment D dated August 27, 2008

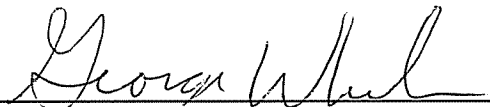
These rejections of claims based on alleged prior art have therefore been overcome by evidence of prior invention, and should be withdrawn.

**Conclusion**

For the reasons stated above, claims 1-64 should be allowed.

Respectfully submitted,

August 27, 2008

A handwritten signature in cursive script, appearing to read "George Wheeler", is written over a horizontal line.

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